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EXAMINER	
JACOBSON, MICHELE LYNN	
ART UNIT	PAPER NUMBER
1782	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,477	FOEGLER ET AL.	
	Examiner	Art Unit	
	MICHELE JACOBSON	1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-16,18-20 and 22-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-16, 18-20 and 22-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Examiner Notes

1. Any objections and/or rejections made in the previous action, and not repeated below, are hereby withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 25 recites "a coating weight ranging from 33 g/m^2 to 59 g/m^2". This range is not supported by applicant's specification as filed. While the specification filed by applicant included individual data points of coating weight of 33 g/m^2 and 59 g/m^2, there is no recitation in the specification of any *range* of coating weights. Therefore, the newly claimed range is not supported. See for example *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of "25%- 60%" and specific examples of "36%"

and "50%." A corresponding new claim limitation to "at least 35%" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range, however a limitation to "between 35% and 60%" did meet the description requirement. In the instant case, no range was originally disclosed, therefore, individual examples cannot be used to provide end points for a range.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-4, 6-16, 18-20 and 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. European Patent Application Publication No. 408164 (hereafter referred to as Ito) and Barmore et al. U.S. Patent Application Publication No. 2001/0008658 (hereafter referred to as Barmore).

6. Ito teaches a water-resistant matrix web with a food flavoring material disposed on it comprising food flavoring material dispersed on a binder material. (Pg. 2, lines 27-30) The water resistant matrix web is recited to be comprised of natural or artificial fiber materials such as polymers of cellulose and other natural materials (viscose, acetate, etc), polyester, polyamide, polyethylene, polypropylene and viscose coated Manilla

paper. (Pg. 2, lines 37-44, 56) Webs produced from such natural or artificial fibers are interpreted by the examiner to read on the textile and consolidated nonwoven support layers recited in claim 1 since the web is made out of fibers which is the definition of a textile and is nonwoven as recited.

7. The food layer is recited to include herbs, pepper, cheese powder and powders of vegetable extracts. (Pg. 3, lines 8-17) The binder layer for the flavoring material is recited to be comprised of polysaccharides such as starch, modified starch, carboxymethylcellulose and protein such as gelatin. (Pg. 3, lines 22-28) The selection of these materials is recited to result in the food layer being neatly transferred onto the surface of the food disposed in a casing made of such a laminate.

8. The laminate is produced by applying a solution of the binder layer material to the matrix web followed by applying the food layer material in a powdery, granular or chip form onto the coated web and drying the thus formed sheet material. The formed sheet may then be formed into a tube for use as a sausage casing by heat sealing the film or by joining the edges of a non-heat-sealable film with the aid of an adhesive tape. (Pg. 3, lines 33-42) When the sheet is brought into contact with a web substrate food, the food material is transferred from the matrix to the substrate food, thus effectively flavoring or spicing the food. (Pg. 4, lines 7-9)

9. Ito is silent regarding the transfer layer being transferred completely onto a foodstuff, the textile support further comprising a barrier layer and a water soluble layer between the textile support and the transfer layer.

10. Barmore teaches a packaging film comprising a first thermoplastic layer which can be coated with a second edible film layer which is transferred to a product during cooking comprising a binder, an additive, a crosslinking agent and a plasticizer. (Para. 8, 11, 196) The film is adhered to the meat product such that upon removing the film from the meat product, the edible film layer remains adhered to the meat product. (Para. 33) The presence of the plasticizer renders the dried composition more flexible, while the binder and the crosslinking agent provide cohesion of the coating. (Para. 196) Additionally, the nature of the binder along with the crosslinking agent is believed to control the rate of hydration of the coating allowing the coating to remain intact against the flow of high moisture meat product. (Para. 196)

11. The additive may comprise caramel, natural colorant, spice or citrate. (Para. 12) The binder may comprise a first binder including alginate, methyl cellulose and hydroxypropyl starch and a second binder comprising materials including albumin, zein, carageenan, casein, soy protein or wheat protein. (Para. 16)

12. The packaging film preferably further comprises a third layer between the first and second layer comprising the materials such as alginate and hydroxypropyl starch to serve as a release layer. (Para. 23) The packaging film of the invention is also recited to comprise a layer which serves as a barrier to oxygen. (Para. 28) The laminate of the invention is recited to be useful for production of casings such as fin-sealed, lap-sealed and butt-sealed casings for meat products. (Col. 32)

13. Both Ito and Barmore are directed towards laminate films for transferring edible films to packaged meat products comprising polysaccharides and proteins. One of

ordinary skill would have been motivated to substitute the coating material recited by Barmore for the coating material disclosed in Ito because of the cohesion and flexibility provided to the coating by the crosslinking agent and plasticizer respectively. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the flavor transfer layer of Barmore for the flavor transfer layer disclosed in Ito. This substitution would have yielded the predictable result of producing a textile support based sausage casing comprising an edible flavor transfer layer with better properties of cohesion and flexibility than that of the film recited by Ito by virtue of the crosslinker and plasticizer. "In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR*, 550 U.S.at ___, 82 USPQ2d at 1395.

14. The obvious substitution of the coating disclosed by Barmore for the transfer coating recited by Ito would have produced the same invention as claimed in claims 1-4, 6, 7, 10, 11, 15, 16, 18 and 19 produced by the method recited in claims 12, 13 and 20.

15. Regarding claims 8, 9 and 14: Barmore clearly discloses utilizing an oxygen barrier layer for the food packaging film recited. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included an oxygen barrier layer in the laminate disclosed by Ito to prevent degradation of the packaged food by oxygen. Since the barrier layer would obviously not be transferred to the packaged food, one of ordinary skill would have provided it on the support layer recited by Ito prior to coating the support with the transfer layer. This obvious utilization

of a barrier layer would have produced the invention claimed in claims 8 and 9 produced by the method claimed in claim 14.

16. Regarding claim 22: Both Ito and Barmore recite binder materials comprising starch and protein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the collagen or gelatin binder recited by Ito for the protein based binder material disclosed by Barmore. The selection of a known material based on its suitability for its intended use supports a *prima facie* obviousness determination. ("Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious)) (MPEP 2144.07) This obvious substitution of known elements would have yielded the same invention claimed in claim 22.

17. Regarding claims 23 and 24: Barmore clearly recites employing a release layer comprising water soluble materials such as alginate and hydroxypropyl starch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included this release layer when employing the edible film recited by Barmore to provide a release layer in the invention of Ito. Such an application of a known film would have produced the same invention claimed in claims 23 and 24.

18. Regarding claims 25 and 26: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied result effective variable

of coating weight depending on the amount of coating that was desired to be placed on the meat product. This optimization would have produced a casing with the same coating weight as claimed in claim 25. The flavorings disclosed by Ito are interpreted to be in coarse-grained or piece form and their obvious inclusion in the coating of Barmore reads on the invention claimed in claim 25. The inclusion of a water soluble release layer as claimed in claim 26 has been addressed above.

Response to Arguments

19. Applicant's arguments filed 1/21/10 have been fully considered but they are not persuasive.

20. Applicant's arguments on pages 8-11 or the remarks are moot since the rejection set forth under 35 USC 102(b) in the previous office action is no longer pending.

21. Applicant has asserted on page 12 of the remarks that Barmore fails to teach every element of the claimed invention. However, note that while Barmore does not disclose all the features of the present claimed invention, Barmore is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely, providing edible film layer which is transferred to a product during cooking comprising a binder, an additive, a crosslinking agent and a plasticizer and in combination with the primary reference, discloses the presently claimed invention.

22. Applicant asserts on pages 12 and 13 of the remarks that Barmore fails to teach a release layer while at the same time conceding that Barmore teaches an "intermediate primer layer containing crosslinker and/or release agent". Applicant appears to believe that since Barmore teaches more than one embodiment that one of ordinary skill would be prevented from recognizing the utility of the embodiment comprising only release agent (i.e. the "or" of the combination highlighted". The examiner is not persuaded this is the case and has specifically highlighted the water soluble materials disclosed by Barmore to comprise such a release layer. Furthermore, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed…." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

23. Applicants assertions on page 13 of the remarks regarding the coating weight of the film disclosed in Barmore have been addressed above.

24. Applicant generically asserts on page 13 "that food casings suitable for one application will not automatically work in another application, as each application has its own unique requirements" while failed to specifically enumerate any implied failed of the instant combination. The examiner is therefore not persuaded that there would be no motivation to combine the clearly related teachings of Ito and Barmore as detailed above.

25. Applicant asserts on page 14 that the combination presented by the examiner would not yield the claimed invention. However, the examiner is not persuaded by this

argument since the combination presented comprises all the same elements and materials claimed by applicant utilized for the exact same applications. Applicant's further arguments on pages 14 and 15 have been addressed above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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